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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,743	12/04/2003	Andrew J. Szabo	93988	2233
22342 7590 10/01/2010 FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER				
SAX, STEVEN PAUL				
ART UNIT		PAPER NUMBER		
2174				
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10/01/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/728,743

**Applicant(s)**

SZABO, ANDREW J.

**Examiner**

Steven P. Sax

**Art Unit**

2174

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on amendment 3/29/10 and RCE 4/26/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-33, 40, 41, 43, 44, 47, 48 and 50 is/are allowed.
- 6) ☒ Claim(s) 42, 45, 46, 49, 51 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Prior Person's Patent Drawing Review (PTO-544)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date see attached.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

#### **DETAILED ACTION**

1. The RCE filed 4/26/10 has been entered. Accordingly, the amendment filed 3/29/10 has been entered.

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The statement that "Claim 1, in contrast to claim 25, recites a graded representation portion, which is not believed to be required for patentability" is not a basis for a reissue application since claim 25 continues to recite "graded representation portion." Further, had claim 25 or any claim canceled this phrase, it would amount to recapture of surrendered subject matter during ex parte prosecution of the patent, thus can not be relied upon as a basis for filing the instant reissue application. Additionally, the statement that "applicant also believes he is entitled to claims which encompass a computer readable medium, e.g. per claims 24 and 32" is not an appropriate basis or error for filing a reissue application since it does not render the "original patent to be wholly or partly inoperative or invalid." The remaining statements in the oath and declaration can not serve as a proper basis of the reissue since claims 34-39 have been canceled, and claim 33 merely attempts to define a computer readable medium of claim 25.

Furthermore, new claims 25-33 and 40-52 recite limitations that are narrower in scope than the patented claims. Therefore, pursuant to MPEP 1402 applicant is required to either amend the patented claims to include the limitations of the new claims or cancel the patented claims.

Claims 1-33 and 40-52 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

In response to this office action, applicant is required to file a newly executed oath and declaration which fulfils the requirements of 35 USC 251. This requirement will not be held in abeyance.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42 and 49 recite the limitation "... in accordance with *the* database output representation operation *parameters*" There is insufficient antecedent basis for this limitation in the claim. The claim earlier recites simply one parameter.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim recites a computer readable medium. Per the specification, this may in fact be a signal. Such a medium is not statutory subject matter.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 45-46 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolton et al (5590325).

7. Regarding claim 45, Kolton et al show: A method comprising: receiving at a server a signal relating to a manipulation of a grade value represented by at least one graded representation portion having at least three states, the at least one graded representation portion comprising a representation of an output criterion as applied to a data set (Figures 4A-C, 5A-C, 7A-C, column 3 lines 50-67, column 4 lines 10-33); defining a query based at least in part on the signal and transmitting electronic

data representing at least one of the query or the manipulation of the grade value to an automated query response system (column 4 lines 36-65, column 5 lines 10-20); and receiving a response from the automated query response system, the response comprising data representing a plurality of items responsive to the query or the manipulation of the grade value (column 5 lines 10-39, column 11 lines 30-65, column 12 lines 42-64).

8. Regarding claim 46, the signal received through the graphic user interface relates to a separate manipulation of a grade value represented by a plurality of graded representation portions (column 4 lines 36-65, column 5 lines 10-20).

9. Claim 51 shows the same features as claim 45 and is rejected for the same reasons.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolton et al (5590325) and Whitmyer, Jr. (5895468).

12. Regarding claim 52, in addition to that mentioned for claim 25, Kolton et al do not specifically go into the details that the data is transmitted using an applet, but do mention transmitting data over a network to access databases. Furthermore, Whitmyer, Jr. does show transmitting data using an applet for convenient access to databases over a network (column 5 lines 37-65 for example). It would have been obvious to a person with ordinary skill in the art to use applets in the invention of Kolton et al, because it would allow convenient access to databases over a network.

13. Claims 1-33, 40-41, 43-44, 47, 48, 50 are allowable over the prior art of record. Independent claim 1 is the method which brings out receiving an output database set from the database in accordance with the database query operation parameter, in which the relative arrangement of members of the output database set is responsive to manipulation of the graded representation portion by the user. Independent claim 25 is the method which brings out determining a query defined based on a graphic manipulation of the graded representation and receiving a query response set comprising a plurality of items in dependence on the query and having an arrangement varying in dependence on a second output criterion derived from the graphic manipulation of the at least one graded representation of the output criterion. Independent claim 40 is the method like independent claim 1, reciting that the relative arrangement is dependent on the operation parameter which is derived from user manipulation of the graded representation portion. Independent claim 43 is the method like independent claim 1 and also reciting the pointing device. Independent claim 50 is the non-transitory computer readable medium equivalent to independent claim 43.

These features in combination with the other elements of the claims combined are not set forth in the prior art of record.

14. Applicant's arguments filed have been fully considered but they are not persuasive. Most of the argument is moot in that many of the argued claims are in fact now allowed in view of the amendment. In addition, the 101 rejection for the other claims (except claim 24) has been overcome. However, regarding claim 45 (and thus new claim 51), Kolton et al do in fact show the grade manipulation. The other features of the allowed claims in combination with this feature are what distinguish over Kolton et al.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven P. Sax whose telephone number is (571) 272-4072. The examiner can normally be reached on Monday thru Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven P Sax/  
Primary Examiner, Art Unit 2174

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